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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,428	07/18/2003	Mark J. Weinberg	10674.4802	4070
22235	7590	01/14/2005	EXAMINER	
MALIN HALEY AND DIMAGGIO, PA			JASTRZAB, KRISANNE MARIE	
1936 S ANDREWS AVENUE			ART UNIT	
FORT LAUDERDALE, FL 33316			PAPER NUMBER	

1744

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,428

Applicant(s)

WEINBERG ET AL

Examiner

Krisanne Jastrzab

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/18/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because of the inclusion of legal phraseology such as "comprising". Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: it is improper for a figure to be placed within the body of the specification. Applicant should cancel "Fig 1" on page 35 of the instant specification, and if desired, file a separate formal drawing to properly include that figure as part of the disclosure.

Appropriate correction is required.

Claims 38 and 39 are objected to because of the following informalities: claim 38 has an extraneous period after "structure" in line 19, and claim 39 has a comma at the end of the claim instead of a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 is found to be vague and indefinite because it is unclear as to how the concentration of methyl bromide and the time can be inversely varied while still carrying out the "maintaining" step of the independent claim 28. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-9, 11-16, 18-22 and 24-28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Joubert U.S. patent No. 4,804,402.

Joubert teaches the sterilization of sewage and the structure containing it, by sealing a trough containing sewage, contacting the sealed structure with methyl bromide at a concentration and for sufficient time as instantly claimed to achieve sterilization, then flushing the methyl bromide from the sealed area such that the sewage can be reused as fertilizer and the trough reused for treating more sewage. It is held that the trough equates to a “structure” as claimed. Contact times are taught to range from 36 to 72 hours, with specific recitation of 48 hours as well. See the abstract, column 1, lines 10-26, column 3, lines 25-48, column 5, lines 8-15, and lines 27-40 and lines 59-61, column 6, lines 3-15, and lines 43-57, column 8, lines 63-65 and column 9, lines 5-40.

With respect to claim 4, it is held that the “trough” is a “commercial building”.

With respect to claim 14, Joubert teaches inclusion of chloropicrin at column 6, lines 43-46.

Claims 1-2, 5-7 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nagji U.S. patent No. 5,505,908.

Nagji teaches the known and expected use of methyl bromide to sterilize enclosures by sealing that enclosure and then contacting it with methyl bromide in an amount and for a time sufficient to sterilize. See column 1, lines 13-16 and lines 55-68 and column 2, lines 1-55.

Claims 1-2, 15-16 and 28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Goldberg et al., U.S. patent No. 6,245,294.

Goldberg et al., teach sterilization of articles or structures such as containers and equipment, by isolating or sealing them from the environment, contacting them with a sterilant such as methyl bromide at optimally determined times, temperatures, pressures and concentrations, to achieve sterilization, followed by aeration of the sealed area. See column 3, lines 15-30, column 4, lines 30-50, column 6, lines 62-65 and column 7, lines 15-20.

Claims 15-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gruber et al., U.S. patent No. 3,897,210.

Gruber et al., clearly teach the sterilization of a commodity by isolating it from the environment, contacting it with methyl bromide in an amount and for a time to achieve sterilization, and aerating the sealed area prior to removal of the commodity therefrom. See column 1, lines 39-50 and column 2, lines 45-55.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 17, 31-36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joubert as set forth above.

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With respect to claims 3 and 17, Joubert clearly teaches sterilization of pathogenic microorganisms and in view of the recognized definition of sterile being devoid of life, it is held that it would have been obvious to one of ordinary skill in the art that the above method would effectively deactivate and disable all bacteria and spores including those instantly claimed.

With respect to claims 31-32, Joubert is silent as to the ambient humidity, however, it is clearly taught to control the water content of the sewage, which intrinsically acts on the humidity of the sealed containment, in order to obtain proper diffusion of methyl bromide which is affected by water content. As such, it would have been obvious to one of ordinary skill in the art to optimally determine and control the humidity level within the sealed containment to ensure proper diffusion of methyl bromide.

With respect to claims 33-36 and 38-39, Joubert clearly teaches concentration and temperature ranges inclusive of those instantly claimed and it would have been well within the purview of one of ordinary skill in the art to determine the optimal applications thereof.

Claims 3, 17, 5-9, 12-13, 18-22, 24-27 and 29-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al., as set forth above.

With respect to claims 3 and 17, Goldberg et al., clearly teach the achievement of sterilization with the killing of microorganisms including bacteria and spores (see column 3, lines 17-21) and it therefore it would have been obvious to one of ordinary skill in the art that this process would be effective against bacteria inclusive of those instantly claimed.

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With respect to claims 5-9, 12-13, 18-22, 24-27 and 29-39, Goldberg et al., clearly teach that it would have been within the purview of one of ordinary skill in the art to determine optimal time and concentration parameters for utilizing those sterilants listed by not specifically exemplified. See column 7, lines 15-30.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7, 9-20 and 22-27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-27 of prior U.S. Patent No. 6,699,433 B2. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 8, 21 and 28-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,699,433 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are of the same inventive concept merely differing by the range of concentrations claimed, with the instantly claimed range encompassing those of '433, neither range exceeding that recognized in the art as applicable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisanne Jastrzab whose telephone number is 571-272-1279. The examiner can normally be reached on Mon.-Wed. 6:30am-4:00pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 571-272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Krisanne Jastrab", is positioned above the printed name.

Krisanne Jastrab
Primary Examiner
Art Unit 1744

January 13, 2005